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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,192	10/14/2003	Duncan L. Mewherter	LOT920030025US1 (010)	4172
46321 7590 08/01/2008 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487				
EXAMINER				
DEBROW, JAMES J				
ART UNIT		PAPER NUMBER		
2176				
MAIL DATE		DELIVERY MODE		
08/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,192

Applicant(s)

MEWHERTER ET AL.

Examiner

JAMES J. DEBROW

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to communications: Appeal Brief filed 19 May 2008.

Claims 1-22 are pending in this case. Claims 1, 6, and 16 are independent claims.

Reopening of Prosecution After Appeal Brief or Reply Brief

In view of the Appeal Brief filed on 19 May 2008, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Doug Hutton/
Doug Hutton
Supervisory Primary Examiner
Technology Center 2100

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the recited “*machine readable storage*” of **Claim 16**. The Specification does not mention the recited “*machine readable storage*.” Thus, there is no support or antecedent basis for the recited “*machine readable storage*” that allows the meaning of the term to be ascertained, as required in 37 CFR 1.75(d)(1).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5:

The language of the claims raise a question as to whether the claims are directed merely to an abstract idea that would not result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is considered functional descriptive material (software), per se, which is not statutory.

Functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete, and tangible result when used in a computer system.

Dependent **Claims 2-5** merely recite further manipulation or specification of data. Thus, none of **Claims 2-5** produce a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Erol et al. (Pub. No.: 2004/0202349 A1; Filing Date: Apr. 11, 2003) (hereinafter ‘Erol’).

In regards to independent claim 1, Erol discloses *a system for converting slide show presentations for use within non-presentation applications, the system comprising:*

a slide show produced by a slide show presentation application and stored in a native format (0032-0034; Erol discloses a PowerPoint presentation which may contain natural or synthetic images, photos, text or lines of text or a combination of thereof.).

a slide show conversion process configured for coupling to a non-presentation application and programmed both to extract contextual data from said slide show in its native format, and also to convert associated slides in said slide show to raster imagery for use in said non-presentation application (0032-0034; 0111; 0118; Erol discloses a PowerPoint presentation which may contain natural or synthetic images, photos, text or lines of text or a combination of thereof. Erol also discloses presentation slides can be stored as a sequence of images, e.g. as JPEGs, BMPs, etc.(raster imagery). Erol further discloses using Optical Character Recognition (OCR) for extracting text from a PowerPoint file/slide.).

In regards to dependent claim 5, *Erol disclose the system of claim 1, wherein said slide show conversion process further comprises programming for reducing said raster imagery to a size suitable for display in a pervasive device (0041; Erol discloses user interface output devices that in intended to include all possible types of devices and ways to output information from data processing system. Thus Erol suggest reducing said raster imagery to a size suitable for display in a pervasive device.).*

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6-9, 12, 14-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erol in view of Chakraborty (Pub. No.: 2004/0194035 A1; Filing Date: Mar. 31, 2000) (hereinafter 'Chakraborty').

In regards to dependent claim 2, Erol does not expressly disclose *the system of claim 1, wherein said contextual data comprises a slide title for each one of said associated slides.*

However Chakraborty teaches *contextual data comprises a slide title for each one of said associated slides* (0020; 0029; 0032; 0036; Chakraborty teaches extracting

text and non-text (i.e., images) information from an electronic document. Chakraborty further teaches extracting titles and fields along with their coordinates and their styles.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 3, Erol does not expressly disclose *the system of claim 1, wherein said contextual data comprises important text associated with each one of said associated slides.*

However Chakraborty teaches *contextual data comprises important text associated with each one of said associated slides* (0020; 0022; 0024; Chakraborty teaches extracting important form information within portions that has been recognized by the system, i.e. lines as lines, text as text, etc., as well as form information that lies within images.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 4, Erol does not expressly disclose *the system of claim 1, wherein said slide show conversion process further comprises programming*

for generating a markup language document and for disposing said contextual data and said raster imagery within said markup language document.

However Chakraborty teaches *generating a markup language document and for disposing said contextual data and said raster imagery within said markup language document* (0010; 0021; 0056; Chakraborty teaches the extracted information is stored as an XML (extensible markup language) file that follows a predefined DTD (document type definition. Thus Chakraborty teaches disposing said contextual data and said raster imagery within said markup language document.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to independent Claims 6 and 16, Erol discloses *a slide show presentation produced by a slide show presentation application.*

converting said first slide into a raster image (0032-0034; 0111; 0118; Erol discloses a PowerPoint presentation which may contain natural or synthetic images, photos, text or lines of text or a combination of thereof. Erol also discloses presentation slides can be stored as a sequence of images, e.g. as JPEGs, BMPs, etc.(raster imagery).

Erol does not expressly disclose *extracting a slide title for a first slide in the slide show presentation;*

disposing both said slide title and said raster image in a markup language document;

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation;

Chakraborty teaches *extracting a slide title for a first slide in the slide show presentation* (0020; 0029; 0032; 0036; Chakraborty disclose extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles.).

disposing both said slide title and said raster image in a markup language document (0010; 0020; 0021; 0029; 0032; 0036; 0056; Chakraborty disclose extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles. Chakraborty disclose the extracted information is stored as an XML (extensible markup language) file that follows a predefined DTD (document type definition.).

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation (It would have been obvious to one of ordinary skill in the art that the steps of extracting, converting and disposing would be repeated for all selected group of slides within the slide show presentation.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an

information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 7 and 17, Erol does not expressly disclose *further extracting important text from said first slide*.

annotating said raster image of said first slide in said markup language document with said extracted important text.

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation.

Chakraborty teaches *further extracting important text from said first slide* (0020; 0029; 0032; 0036; Chakraborty teaches extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles.).

annotating said raster image of said first slide in said markup language document with said extracted important text (0010; 0037; Chakraborty disclose XML files which are referred to as Anchorable Information Unit (AIU) files. Chakraborty disclose combining a partial AIU file that contains extracted form information with another partial AIU file that contains extracted form information for non-text (images) portions of the input file. Therefore Chakraborty disclose *annotating said raster image of said first slide in said markup language document with said extracted important text*.).

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation (It would have been obvious to one of ordinary skill in the art that the steps of extracting, and annotating would be repeated for all selected group of slides within the slide show presentation.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 8 and 18, Erol discloses *wherein said further extracting step comprises the step of further extracting text having formatting characteristics within said first slide which emphasizes said text* (0031; 0112; 0116; Erol teaches extracting text having formatting characteristics such as color and font size.).

In regards to dependent claims 9 and 19, Erol discloses *wherein said formatting characteristics comprise a point size which exceeds a threshold value* (0091; 0112; 0116; Erol teaches the formulation for threshold selection includes a constant typically based the amount and size of the text in an image. Thus Erol teach/suggest the concept or technique of formatting characteristics comprise a point size which exceeds a threshold value.).

In regards to dependent claim 12, Erol does not expressly disclose *the method of claim 6, further comprising the step of processing said markup language document in a non-presentation application.*

Chakraborty teaches *the method of claim 6, further comprising the step of processing said markup language document in a non-presentation application* (0028; 0078).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 14, Erol does not expressly disclose *the method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation.*

Chakraborty teaches *the method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation* (0020-0025; Chakraborty disclose the steps of extracting, disposing, converting text and non-text formed information.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an

information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 15 and 22, Erol discloses *reducing said raster image to a size suitable for display in a pervasive device* (0041; Erol discloses user interface output devices that in intended to include all possible types of devices and ways to output information from data processing system. Thus Erol suggest reducing said raster imagery to a size suitable for display in a pervasive device.).

Erol does not expressly disclose *rendering said slide title*.

Chakraborty disclose *rendering said slide title* (0020; 0029; 0032; 0036; Chakraborty discloses extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further discloses extracting titles and fields along with their coordinates and their styles.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See MPEP 2123.

Claims 10, 11, 13, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erol in view of Chakraborty, further in view of Chatterjee et al. (Patent No.: US 7,162,691 B1; Filing Date: Feb. 1, 2000) (hereinafter 'Chatterjee').

In regards to dependent claims 10 and 20, Erol in view of Chakraborty does not expressly disclose *wherein said annotating step comprises the step of generating an ALT tag with said important text in association with said raster image in said markup language document.*

However Chatterjee teaches *generating an ALT tag with said important text in association with said raster image in said markup language document* (col. 2, lines 30-37; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio or video data, or program files. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to provide a markup language document containing an ALT tag with said important text in association with said raster image.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify

non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

In regards to dependent claims 11 and 21, Erol in view of Chakraborty does not expressly disclose *wherein said generating step further comprises the step of formatting said ALT tag with additional inline indicators for facilitating an audible playback of said important text in a non-presentation application.*

However Chatterjee teaches *the step of formatting said ALT tag with additional inline indicators for facilitating an audible playback of said important text in a non-presentation application* (col. 2, lines 30-37; col. 4, lines 51-62; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio or video data, or program files.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

In regards to dependent claim 13, Erol in view of Chakraborty does not expressly disclose *the method of claim 12, wherein said processing step comprises the step of generating an agenda with each slide title for each raster image in said markup language document.* Chakraborty disclose extracting text and non-text (i.e., images)

information from an electronic document. Chakraborty further discloses extracting titles and fields along with their coordinates and their styles (0020; 0029; 0032; 0036).

Chatterjee teaches *wherein said processing step comprises the step of generating an agenda with each slide title for each raster image in said markup language document* (col. 2, lines 30-37; col. 4, lines 51-62; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio or video data, or program files. It would have been obvious to one of ordinary skill in the art to modify Chakraborty's teaching with Chatterjee's teaching of markup tags for the benefit of generating an agenda with each slide title for each raster image in said markup language document.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.
See, MPEP 2123.

Response to Arguments

Applicant's arguments, see Appeal Brief, filed 19 May 2008, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of w Erol, Chakraborty and Chatterjee.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JAMES DEBROW
EXAMINER
ART UNIT 2176

/Doug Hutton/
Doug Hutton
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